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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/806,818

03/22/2004

Masashi Hiroki

04190/LH

3706

1933 7590 06/02/2008

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC  
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EXAMINER

MCCLENDON, SANZA L

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Notice of Allowability**

Application No.

10/806,818

Examiner

Sanza L. McClendon

Applicant(s)

HIROKI ET AL.

Art Unit

1796

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 4/25/2008.
2. ☒ The allowed claim(s) is/are 1,2,11,12 and 17-29.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application                      |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>4/25/2008</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                    | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the Amendment received on April 25, 2008, the examiner has carefully considered the Information Disclosure Statement.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on April 25, 2008 was filed after the mailing date of the Notice of Allowance but before the Issue Fee Payment on 4/25/2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. The rejection JP2003-89261 is distinguished from the instant invention since it does not require the use of an oxetane compound.

## **Drawings**

3. The drawings, filed 6/28/2004, are accepted by the examiner.

### ***Response to Arguments***

4. Applicant's arguments, see Remarks/Amendment, filed March 11, 2008, with respect to claims 1-, 11-12, and 16-30 have been fully considered and are persuasive. The rejection of claims 1-2, 11-12 and 17-29 under 35 USC 103(a) as being unpatentable over Takabayashi et al (7,244,472 and 7,084,184) in view of Mantell et al (EP 0 779 346 and US 5,641,346) has been withdrawn. Applicant's amendment to the claims, positively requiring that the oxetane compound content in the solvent as found in the instant claims be in an amount from 10 to 40 parts by weight distinguishes the instantly claimed invention over the cited prior art of record. Takabayashi et al sets forth similar inks, however Takabayashi et al requires the oxetane content in said inks be found in amounts from 60 to 95% by weight of the total ink composition.

***Allowable Subject Matter***

5. Claims 1-2, 11-12, and 17-29 are allowed.
6. The following is an examiner's statement of reasons for allowance: The prior art, alone or in combination, fails to teach an ink composition comprising a polymerizable solvent positively comprising an oxetane compound in amounts from 10 to 40 parts by weight based on the entire amount of solvent and a reaction liquid that can generate an acid upon irradiation with light that is prepared separately from the ink composition and mixed with said ink immediately prior to introduction into a printer recording head. Nor does the prior art teach said ink composition having the instantly claimed viscosities. Takabayashi et al teaches similar inks, however the inks of Takabayashi et al comprising oxetane compounds in amounts from 60 to 95% by weight, which is outside the instantly claimed range. Additionally, Takabayashi et al does not positively teach separately preparing a reaction liquid comprising an acid generating compound upon light and not mixing such component until immediately prior to being introduced into a printing head.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/

Primary Examiner

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SMc